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 Appl. No.: 09/651,431

# VERSION WITH MARKINGS TO SHOW CHANGES MADE:

## IN THE CLAIMS:

Claim 1 has been amended as follows:

1. (Twice Amended) A method of manufacturing a bending-resistant, torsionally yielding tubular profiled member as a transverse support of a twist beam rear axle of a passenger car, the method comprising the steps of: cold-forming a tube blank of tempering steel to a tubular profiled member with a torsionally yielding central longitudinal section of a U-shaped cross-section and with opposed torsion-proof end sections, ~~wherein the tempering steel of the tube blank is of the specification 22MnB5;~~ annealing transitional sections of the tubular profiled member located between the torsionally yielding central longitudinal section and the opposed torsion-proof end sections at a temperature level between ~~820° C and 950° C~~ 850° C and 960° C; hardening the tubular profiled member in water at a temperature above the AC3 point; tempering the tubular profiled member at a temperature ~~of approximately 280° C~~ between 200 °C and 550 °C for a duration of ~~approximately 20~~ more than five minutes; subjecting the tubular profiled member at least to an outer surface hardening process; and

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subjecting the tubular profiled member to further configuration processing steps for completing a twist beam rear axle.

9. (Twice Amended) A method of manufacturing a bending-resistant, torsionally yielding tubular profiled member as a transverse support of a twist beam rear axle of a passenger car, the method comprising the steps of: cold-forming a tube blank of case hardening steel to a tubular profiled member with a torsionally yielding central longitudinal section of a U-shaped cross-section and opposed torsion-proof end sections, ~~wherein the case-hardening steel of the tube blank is of the specification C15;~~ case-hardening transitional sections of the tubular profiled member located between the torsionally yielding central longitudinal section and the opposed torsion-proof end sections during a heat treatment with carburization of the surface of the tubular profiled member and subsequent quenching; subjecting the tubular profiled member at least to an outer surface hardening process; and subjecting the tubular profiled member to further configuration processing steps for completing a twist beam rear axle.
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Claims 14, 15, 16 and 17 have been added.

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## REMARKS

The last Office Action of August 30, 2002 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1, 3, 6, 7, 9, 12 and 13 are pending in the application. Claim 1 has been amended. Claims 14-17 have been added. Enclosed is also a marked-up version of the changes made to the claims by the current amendment. The enclosed page is captioned **"VERSION WITH MARKINGS TO SHOW CHANGES MADE"**.

Claims 1, 3, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. EP 0 752332 A1 (hereinafter "Toepker et al.") in view of Metals Handbook Volume 1 (hereinafter "Handbook Vol. 1 ") and ASM Handbook Volume 5 (hereinafter "Handbook Vol. 5).

Claims 9-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Toepker et al. in view of ASM Handbook Volume 4 (hereinafter "Handbook Vol. 4 ") and Handbook Vol. 5.

Record is also made of a telephone interview between applicant's representative and the Examiner which took place on January 14, 2003. The Examiner is thanked for his help and assistance as well as for the courtesies extended to Counsel at that time. During the course of the interview the present application was extensively discussed, and applicant's representative referred in particular to the differences between the subject matter of the present invention

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and the applied prior art. More specifically, applicant's representative noted as follows: Applicant respectfully disagrees with the Examiner's rejection of claims 1 and 9 for the following reasons:

The present invention is directed to a particular process to produce a particular element in a twist beam axle for motor vehicles, namely a torsionally-yielding profiled member with rigid end sections, whereby a particular focus is directed to the properties of the transition between the midsection of the profiled member and the end sections thereof.

The Examiner based his obviousness rejection on a combination of Toepker et al. with Handbook Vol. 1 and Handbook Vol. 5, or on a combination of Toepker et al. with Handbook Vol. 4 and Handbook Vol. 5. The Examiner noted hereby that Toepker et al. teaches a transverse support, although it does not teach any processing steps to make this support. However, the Examiner noted further that it is of basic knowledge to apply press forming, and heat treatment is also known from the Handbook Vol. 1. This argumentation by the Examiner is not proper to establish a case for obviousness. Claims 1 and 9, as now on file, teach a combination of particular process steps to make a particular product with particular properties. Claims 1 and 9 do not claim a forming step per se or a heat treatment step per se, but a combination of process steps. As stated by the Federal Circuit in *In re Rouffet*, 47 USPQ2d, 1453, 1457 "Most, if not all, inventions are combinations and mostly of old element. Therefore, an examiner may often find every element of a claimed invention in the prior art. If

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identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue".

In the case at hand, the Examiner's reasoning is ill-advised also because since the prior art, in fact, fails to disclose each claimed element, the Examiner bridges the absence of a teaching or suggestion of claim elements of claims 1 and 9 by simply making a broad conclusion that this is basic knowledge. As stated by the Federal Circuit in *In re Lee*, 61 USPQ2d, 1434, 1435, "Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.". The Court also stated that "The Board's findings must be documented on the record,".

It is applicant's contention that the Examiner failed to make a case of obviousness and failed to present proper evidence to substantiate his conclusions.

The Examiner indicated during the interview that the subject matter of the present invention may be distinguishable over the applied prior art, especially also because of his failure to properly appreciate the relevancy of the steps relating to the production of the transitional sections of the profiled member.

As a result of the interview, applicant now submits this amendment to place the application in formal condition for allowance.

More specifically, applicant has amended claim 1 by setting forth broader temperature ranges and time periods. Support therefore can be found in the original version of claim 1 and throughout the specification. The reasoning for broadening the claim elements in this manner is based on the fact that claims 1

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and 9 derive their novelty and inventiveness from the combination of the process steps, as set forth in claims 1 and 9. The reference to the narrow temperature range and time period as well as to the particular type of material used, as previously claimed, represents merely the presently preferred embodiment for the particular process that the inventor contemplated. Thus, to include all these limitations in claim 1 and the limitation of the material used in claim 9 would not properly define the full scope of what the inventor has invented and would rather limit the applicant to his preferred embodiment which is not justified in view of the art. The narrow temperature range, time period and material selection have now been set forth in newly submitted claims 14, 15, 16, 17, respectively. Please note that the subject matter of claims 14-17, in fact, corresponds to original claims 2, 4, 5 and 10.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the

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undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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